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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188736
Party	Defendant Anastasia Marie Laboratories, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**ANASTASIA BEVERLY HILLS, INC.**  
**ANASTASIA SOARE**  
**ANASTASIA SKIN CARE, INC**

Opposers,

v.

**ANASTASIA MARIE LABORATORIES, INC.**

Applicant.

Opposition No. 91188736

**MOTION TO COMPEL AND FOR EXTENSION OF TIME**

Applicant, Anastasia Marie Laboratories, Inc. (hereinafter “AML”), by counsel, moves the Board for an Order compelling discovery pursuant to Rule 37 of the Federal Rules of Civil Procedure, 37 CFR § 2.120(e) and TBMP §§ 411.01 and 523.01. Applicant also moves pursuant to Rule 6(b) of the Federal Rules of Civil Procedure, 37 CFR § 2.120(a) and TBMP §§ 509 and 403.04 for an extension of the period of discovery for sixty (60) days from the Board’s Order ruling on the motion to compel to permit follow-up discovery in the form of depositions.

Such an order is appropriate because Opposers have failed to provide basic information and documents relating to their claims of priority and use of their “ANASTASIA BEVERLY HILLS” marks. Opposers have not produced any documents which are sufficient to show annual sales of all of their products or of any product under their marks. Nor have they provided documents which could even provide any idea of what sales might have been for the critical five year period from 2000 through 2004. Particularly in view of Opposers’ massive revisions of their claims of use of their marks in connection with most products during this proceeding and

history of misrepresenting their rights, Applicant has sought the documentary support for Opposers' claims with respect to the products remaining in the registrations.

As shown by the declaration attached hereto as Exhibit A ("Taylor Declaration"), the undersigned counsel for Applicant has made repeated good faith efforts to resolve the discovery deficiencies with counsel for Opposers in a number of letters, e-mails and telephone discussions. While these efforts have resulted in further document production on April 6, 20, 23 and 25, as is evident from the last correspondence from counsel for Opposers attached to the Taylor Declaration (Exs. 10 and 11), counsel for Opposers simply refuses to address the basic question of whether Opposers have records of sales of their products under their marks and income from rendering their services under their marks so that it can be determined whether they have the rights they now claim.

Although the letters attached as Exhibits to the Taylor Declaration show many deficiencies in Opposers' responses and document production, this motion to compel is directed only to four document requests and two interrogatories.

## **I. BACKGROUND**

On January 29, 2009, Opposers filed a Notice of Opposition to Applicant's application for registration of "ANASTASIA" for use in connection with body cream, body lotion, hand cream, hand lotions, and skin cleansing lotion (Ser. No. 77/150,306). Opposers, Anastasia Beverly Hills, Inc. (hereinafter "ABH"), Anastasia Soare, and Anastasia Skin Care, Inc. relied on four registrations: Registration Nos. 2,798,069 for "A ANASTASIA BEVERLY HILLS" plus design, 2,821,892 for "ANASTASIA BEVERLY HILLS", 3,503,367 for "A ANASTASIA BEVERLY HILLS" plus design, and 3,342,405 for "ANASTASIA BEVERLY HILLS".<sup>1</sup> Opposers claimed that they had used its marks in connection with the sale of a wide variety of

cosmetics and skin care products in International Class 3 as well as on and in connection with related tools in International Classes 12 (“eyebrow tweezers and eyebrow grooming scissors”) and 21 (“cosmetic brushes”) and in connection with “beauty salon services, namely, hair removal, dressing and styling” in class 44.

On March 16, 2009, Applicant filed an Answer and Counterclaim to Cancel Opposers’ Pleadings Nos. 2,798,069 and 2,821,892 on the grounds of fraud. On January 14, 2010, Opposers filed a motion to dismiss the Counterclaims, alleging that Applicant failed to allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b). Opposers admitted, however, that the marks had not been used on a number of products in connection with which use had been claimed. For example, in paragraph 20 of Anastasia Soare’s Declaration attached to Opposers’ Motion to Dismiss, she stated that she “did not realize that the 2001 ABH Amendment would be interpreted to mean that ABH was claiming that it was then using the mark other than would be apparent from the specific product specimens provided to counsel i.e. “eyebrow highlighting pencils, eye liners, cosmetic wax, candles, cosmetic brushes, and tweezers...”.

Therefore, in conjunction with the motion to dismiss, Opposers moved to amend U.S. Registration Nos. 2,821,892 for ANASTASIA BEVERLY HILLS and 2,798,069 for ANASTASIA BEVERLY HILLS & Design to delete class 4 and to delete most of the products in class 3 i.e. “potpourri”, “loose powder”, “eye shadow base”, “bronzing products”, “nail polish”, “nail base coat”, “nail top coat”, “facial cleansers”, “facial cleansing bars”, “facial toners”, “facial astringents”, “facial masques”, “facial exfoliators”, “body cream”, “body lotion”, “body powder”, “body moisturizers”, “body lotions”, “body toners”, “body astringents”, “hand creams”, “body cleansing products, namely, creams, gels, and bar soaps”, “fragrance products,

namely, perfume, eau de parfum, eau de toilette, eau de cologne, and fragranced creams, lotions, gels, bar body toners, and astringents, room fragrances". Opposers also moved to amend the alleged dates of first use and first use in commerce.

On February 12, 2010, Applicant filed a motion for summary judgment on its claims of fraud. On March 31, 2010, Opposers filed a motion for Summary Judgment on its Amended Counterclaims. On June 30, 2010, the TTAB issued a ruling denying both Opposers' motion to dismiss and Applicant's motion for summary judgment.

In October 2010, Applicant contacted the undersigned counsel to represent it in these proceedings. Settlement discussions were undertaken, and in view of the settlement discussions, on December 21, 2010, Opposers filed a consent motion for extensions of time, resulting in the extension of the closing date of discovery to April 26, 2011 (Taylor Dec. ¶ 3).

However, in late February it became apparent that settlement discussions had failed, and on February 25, 2011, counsel for Applicant sent a letter to counsel for Opposers in which he identified significant deficiencies in the discovery which had been provided to counsel's predecessor. (Taylor Dec. ¶ 4 and Exs. 1 and 2). On February 28, Applicant served further requests for document production and for requests for admission, and Applicant received responses both to its deficiency letter and its discovery requests on April 4, 2011. Counsel for Applicant sent letters to counsel for Opposers on April 11 and April 14 in connection with deficiencies in both Opposers' responses and document production in connection with Applicant's new discovery requests and the responses to the requests from his predecessor as counsel. Counsel for Applicant received letter responses on April 13 and April 18. Opposers provided further document production on April 6, 20, 23 and 25 and have been continuing in

subsequent e-mails to promise further document production (Taylor Dec. ¶¶ 5-13 and Exs. 3 - 11).

## **II. ARGUMENT**

### **A. Motion to Compel**

Applicant respectfully requests that the Board compel complete discovery responses including document production as specified below. The scope of discovery in Board proceedings is governed by Federal Rule of Civil Procedure 26(b) which provides:

Parties may obtain discovery regarding any matter not privileged that is relevant to the claim or defense of any party . . . Relevant information need not be admissible . . if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.

Fed.R.Civ. P. 26(b)(1); TBMP § 402.01.

The discovery requests that are the subject of Applicant's Motion to Compel seek relevant discoverable information or documents as defined by Federal Rule of Civil Procedure 26(b)(1) and TBMP § 402.01, but Opposers' responses and document production show a continuing effort to withhold information and documents which would enable Applicant to evaluate its claims.

#### **1. Documents Relating to Claims of First Use and Priority**

Applicant's Request Nos. 3 and 23 in the Third Set of Document Requests requested documents sufficient to show the first sale of each of the products which has been sold under any of its claimed marks and the documents which would support Opposers' claims of having prior rights. Information and documents regarding first use and dates of use of pleaded marks are relevant and discoverable. TBMP § 414(5); *see e.g. Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195-96 (TTAB 1976); *Miller & Fink Corp. v. ServiceMaster Hospital Corp.*, 184 USPQ 495, 496 (TTAB 1975).

Document request nos. 3 and 23 are as follows:

For each of Opposers' products, produce those documents sufficient to show the earliest sale of the product under any of the Opposers' Marks anywhere, and the sale of the product under any of Opposers' Marks in commerce.

Produce any and all documents that support Opposers' position of having prior rights with respect to the use of "ANASTASIA" as or in a mark for skin care products.

The only document Opposers have produced which is even purported to show first use of a mark in connection with a sale of a product is a document showing a shipment of after-tweeze cream from a manufacturer, Kolmar Laboratories, to a distributor in New Jersey, ADS, Inc., on March 16, 2000.

In their responses to these requests, Opposers stated that they would provide further document production, but the responses themselves show that they have no intention of complying with the discovery requests. In response to request no. 3, Opposers stated that they would provide "documents summarizing units sold of ABH-branded goods in class 3 on a semi-annual basis from 2005 to the present", referred to a confidential product chart created for the litigation, and referenced a few documents showing shipments of products to its distributor and an invoice to Nordstroms dated August 21, 2000. (Ex. 6)

Based on Opposers' own representations, records from 2005 to the present would not appear even relevant to document production requests concerning first use and priority. That is, Opposers are claiming first use since March, 2000, claiming priority over the May, 2000, first use date stated in the opposed application. Also, Anastasia Soare represented in paragraph 37 of her declaration of January 14, 2010 (submitted with Opposers' motion to dismiss), that Opposers had used their mark on all products as of August 2003.

Further, when the promised documents were produced on April 20, they did not show sales under the marks but rather consisted of invoices to ABH from the manufacturers and an unsupported spreadsheet prepared for litigation purposes which purports to show the number of units of different types of products that were shipped out during those years from the ABH warehouse. It is simply unknown to what extent the products sent to ABH from manufacturers or shipped out from the ABH warehouse for use in the salon or elsewhere were products bearing Opposers' marks. Opposer refuses to state whether ABH itself kept track of sales of the branded products and, if not, to explain why it refuses to produce documents showing the sales.

The most important feature of the lawyer-created "confidential chart" (Ex. 4) referenced in the response is that, though it makes specific claims of use, the documents produced by Opposers do not begin to support the claims, and it is readily apparent from simple comparisons with other documents that the "confidential chart" is false and incomplete. For example, a number of products for which current use is claimed in the "confidential chart" have been deleted from the registrations as not being in use, and, more significantly, the chart is completely inconsistent with the declaration of Anastasia Soare filed in connection with the motion to dismiss, which in paragraph 37 claims use as of 2003 for products which do not even appear on the chart or for which the chart shows no use. With its incompleteness and inconsistencies, its false groupings of products so that the sale of a single product is supposed to represent four different products, its false equations of product types, its selective occasional descriptions of products as branded or unbranded, and its selective specificity as to dates, the "confidential chart" is useless.

Further, it is very significant that although, as stated in Applicant's letter of April 11, on January 17, 2010 (nearly a year and a half ago), Opposers had promised that "our client will



commence searching its pre-2005 business records for documentary evidence of early sales and/or shipments of ABH-branded product” (Ex. 5), as recently as April 23, Opposers are representing that they have located “detailed computer generated reports from ADS for 2002 and is searching for similar reports from ADS” (Ex. 10), and, as recently as April 25, Opposers are representing that they will search for time periods prior to 2005 other than 2002 (Ex. 11). ADS is a distributor. There has been no explanation as to why Opposers, particularly ABH, cannot produce its own records of sales under the marks. Although Opposers have produced some isolated invoices from ABH, they are either incapable or, as is more likely, simply unwilling to produce actual ABH sales records for products sold under the marks for any year or years. Applicant has very little more than a series of contradictory lawyer-created statements with respect to Opposers’ claims of first use and priority.

## **2. Documents Showing Sales of Products and Rendering of Services Under the Marks**

Request Nos. 9 and 10 in Applicant’s Third Set of Requests for Production of Documents and Things seek financial documents relating to the sale of goods and income from services rendered under Opposers’ marks from the alleged date of first use to the present. Information and documents relating to sales figures are discoverable. In *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985).

Request Nos. 9 and 10 are as follows:

Produce those documents sufficient to show the dollar value of actual sales of each of Opposers’ Products for each year beginning with the date of first use of any of Opposers’ Marks in connection with the sale of the product.

Produce those documents sufficient to show the dollar value of income received from rendering each of Opposers’ Services for each year beginning with the first use of any of Opposers’ Marks in connection with the rendering of services.

In response to Request No. 9, Opposers stated that they would produce “representative Salon Commission Reports reflecting income from retail sales in the Anastasia Beverly Hills Salon in 2000, 2001 and 2002” and promised to produce the same spread sheet summarizing units shipped from its warehouse from 2005 to the present.

Apart from the fact that Opposers simply omit 2003 and 2004, as is evident from the “confidential chart”, products other than “ABH-branded” products were being sold in the salon, and, as Opposers are well aware, there is simply no way to ascertain sales of ABH-branded products from these reports. Further, the reports are grossly incomplete even for the few years selected by counsel. With respect to the created spread sheet from 2005 to the present, again, it does not show sales and does not even purport to show shipments from the warehouse of ABH-branded products. Applicant is left with almost nothing on which to gain an understanding of actual sales of products under the marks, particularly during the early years on which Opposers’ claims of priority are based.

In response to Request No. 10, Opposers state that they will produce Salon Service Commission Reports reflecting income from services rendered in the Anastasia Beverly Hills Salon in 2000, 2001, and 2002, with no explanation as to why it is producing discovery only as to these years. The request asks for documents evidencing the dollar value of income received from rendering each of Opposers’ Services *for each year* beginning with the date of first use of the marks.

Opposer states in its responses that “Opposers’ archived business records for the calendar years 2000 through 2008 were made available to counsel for AML in Opposers’ warehouse in Sylmar, California, on or about January 16, 2010” (though it subsequently made the promise to Applicant’s predecessor counsel referenced above to search its records for pre-2005 documents).

This, like counsel's statement in his e-mail of April 23 (Ex. 10) that Opposers will make people available to assist counsel in "inspecting ABH current and historical production and shipping records" in their warehouse in Sylmar is a transparent effort to force counsel to waste time and incur significant expense in going through raw warehouse shipping and production documents rather than simply provide the documents which would show sales of products under the marks and would enable Applicant to evaluate Opposers' claims.

Opposer's e-mail sent on the night of April 25 (Ex. 11) evidences counsel's attitude towards discovery obligations:

"In my opinion, when taken in conjunction with the Fishbowl data already sent you, these documents are more than sufficient to establish whether or not there was a three year period of non use as to any particular goods. As to dollar volume for particular types of goods, to the extent this information is not evident from what has already been produced (or remains available for your inspection and/or copying), we repeat our earlier objections as to your requests as being burdensome, irrelevant, and untimely."

Opposers do not appear to recognize that their obligations extend to more than trying to show indirectly and certainly not clearly "whether or not there was a three year period of non use as to any particular goods".

### **3. Responses to Interrogatories Relating to Interruptions in Use**

Opposers' failure to comply with discovery obligations is further exemplified by its responses to the interrogatory nos. 10 and 11 of Applicant's predecessor counsel on November 13, 2009 (Ex. 2).

Interrogatory Nos. 10 and 11 are as follows:

For each product and service requested to be identified in interrogatory No. 6 [every product and service in connection with which the "A ANASTASIA BEVERLY HILLS" mark has been used] explain the extent to which there has been any interruption to continuous use of the "A ANASTASIA BEVERLY HILLS" mark to identify the product and services

For each product and service requested to be identified in interrogatory No. 7 [every product and service in connection with which the "ANASTASIA BEVERLY HILLS" mark has been used]

explain the extent to which there has been any interruption to continuous use of the "ANASTASIA BEVERLY HILLS" mark to identify the product and services

In response to both interrogatories, Opposers stated as follows:

Opposers have discontinued production of [mark] branded foundation, bronzing products and bronzing liquid from in or about October 2009 to the present while the products are being reformulated for reintroduction in 2010.

Opposers discontinued production of [mark] branded lipsticks for approximately one year in or about 2007 while the products were being reformulated.

Opposers discontinued production of [mark] branded facial serum, eye gels and eye-area gels from in or about 2001 to in or about November, 2006.

Sales of [mark] branded fragranced creams and lotions, body lotions, body moisturizers and hand creams were interrupted in 2005.

Opposers have offered manicure services in a [mark] branded salon in the past and are planning to offer such services in a [mark] branded salon in early 2010.

These statements are grossly and obviously inconsistent with, for example, the subsequent deletion of the majority of products identified in the registrations, including many products not even mentioned in these responses, and, on the other hand, with the claims made in the declaration of Anastasia Soare (which, for example, claimed use of the mark in 2003 for "facial serum, eyes gels and eye-area gels" as well as many other products which were subsequently deleted from the registrations), and they show the unreliability and lack of credibility of statements made by or on behalf of Opposers.

#### **B. Motion for Extension of Time**

Applicant respectfully requests that the Board extend the discovery and trial dates for an additional sixty (60) days upon resumption of proceedings.

As is evident from the preceding, Opposers have still not produced basic discovery concerning their claims, and though Opposers continue to promise that they will provide further discovery and will update responses, they have taken no steps to date to bring clarity to a completely confused and misleading record. Opposing counsel has already agreed at least to a thirty day extension from the date that it last produces discovery for the scheduling of

depositions, and, as of yesterday evening, opposing counsel has also served numerous additional discovery requests (Taylor Dec. ¶¶ 11-12).

Following the breakdown in February of the settlement discussions which had begun as soon as the undersigned was retained as new counsel in October, 2010, the undersigned immediately followed up on the deficiencies in the discovery which had been provided to predecessor counsel and with additional discovery requests. The undersigned then followed up immediately on the deficiencies in the responses to the new discovery requests and the document production. Because Applicant has been unable to obtain either meaningful or reliable discovery from counsel despite diligent efforts over the past two months, it is submitted that this extension is sought for good cause and not for the purposes of delay.

### **III. CONCLUSION**

In view of the foregoing, it is requested that the Board order that Opposers provide complete responses to the interrogatories above and produce documents in accordance with the requests discussed above and that the Board schedule at least sixty (60) days for follow-up on resumption of proceedings.

Respectfully Submitted,

**STITES & HARBISON PLLC**

  
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**April 26, 2011**

**Certificate of Service**

I hereby certify that a true copy of the foregoing APPLICANT'S MOTION TO COMPEL AND FOR EXTENSION OF TIME and the attached DECLARATION OF BREWSTER TAYLOR and EXHIBITS 1-11 were sent via U.S. first class mail on April 26, 2011, to John May, Berliner & Associates, 555 West Fifth Street, 31st Floor, Los Angeles, CA 90013, and via email to John May at [jmay@berliner-ip.com](mailto:jmay@berliner-ip.com).

  
Mari-Elise Gates

# EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**ANASTASIA BEVERLY HILLS, INC.**  
**ANASTASIA SOARE**  
**ANASTASIA SKIN CARE, INC**

Opposers,

v.

**ANASTASIA MARIE LABORATORIES, INC.**

Applicant.

Opposition No. 91188736

**DECLARATION OF BREWSTER TAYLOR**

The undersigned, Brewster Taylor, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this document, declares as follows:

(1) I am a member of the firm of Stites & Harbison, PLLC, attorneys for Applicant in the above-identified proceeding;

(2) I was contacted by Applicant in connection with representing it in the proceeding in October, 2010, and filed a Power of Attorney with the Trademark Trial and Appeal Board on October 14, 2010;

(3) I began settlement discussions with counsel for Opposer on October 20, 2010, and, in view of continuing settlement discussions, including telephone discussions and written proposals, on December 21, 2010, Opposers filed, with Applicant's consent, a request for a sixty day extension of discovery and trial dates for the purpose of further settlement discussion;



(4) Settlement discussions concluded unsuccessfully in late February, and in a letter dated February 25, 2011, (attached as Exhibit 1), Applicant made requests in connection with certain responses provided to our predecessor firm in response to its discovery requests (attached as Exhibit 2) and related document production;

(5) On February 28, 2011, Applicant served on Opposer a third set of document production requests and a second set of requests for admission;

(6) On April 4, Opposers served responses to Applicant's new discovery requests, and by letter dated April 5, 2011 (attached as Exhibit 3), Opposer responded to Applicant's letter of February 25, referencing a "confidential chart" created by counsel (attached under seal as Exhibit 4);

(7) By letter dated April 11 (attached as Exhibit 5), Applicant responded to Opposers' letter of April 5, and followed up on the deficiencies in responses and document production provided in connection with the new document requests and requests for admission (responses to four document requests are attached as Exhibit 6) and related document production, and in a letter dated April 13 (attached as Exhibit 7), counsel for Opposer responded to Opposers' letter of April 11;

(8) Counsel for Applicant followed up with a letter dated April 14, 2011 (attached as Exhibit 8), and Opposers responded in a "confidential" letter dated April 18 (attached under seal as Exhibit 9);

(9) Counsels for Applicant and Opposers had a number of telephone discussions concerning deficiencies in Opposers' production of documents during the April 17 – April 23, and twice during those discussions, counsel for Applicant promised to produce further

documents and stated that he would agree to a thirty day extension of the discovery period from the date further documents were produced for the purpose of scheduling depositions;

(10) Opposers' counsel's e-mail of Saturday, April 23, promising further documents is attached hereto as Exhibit 10;

(11) Opposers' counsel's e-mail received on the night of Monday, April 25, is attached hereto as Exhibit 11;

(12) On Monday, April 25, Opposers' counsel also served second sets of interrogatories, requests for documents and requests for admissions;

(13) I have made good faith efforts to resolve these proceedings in settlement discussions with Opposers from the time of my engagement in these proceedings in October 2010 to the time settlement discussions failed in February 2011, and have attempted in good faith to resolve discovery disputes with counsel for Opposers through letters, e-mails and telephone discussions from February until the present date;

(14) All statements made on my own knowledge are true, and all statements made on information and belief are believed to be true.

**April 26, 2011**

A handwritten signature in black ink, appearing to read 'Brewster Taylor', written over a horizontal line.

**Brewster Taylor**

# EXHIBIT 1

February 25, 2011

**VIA E-MAIL AND FIRST CLASS MAIL**

Robert Berliner  
Berliner & Associates  
555 West Fifth Street  
31<sup>st</sup> Floor  
Los Angeles, California 90013

Re: ABH v. AML – Opposition No. 91188736

Dear Mr. Berliner:

This is further to our telephone discussion and your e-mail of earlier this month. Our client is very disappointed that your client is no longer interested in reaching settlement along the lines that your colleague, Mr. May, and I were discussing.

In light of recently discovered evidence, we will be supplementing our discovery responses and documentation shortly to show that our client has used “ANASTASIA” alone for skin care products since prior to even the alleged first use of “ANASTASIA BEVERLY HILLS” for skin care products by your client. The parties are in agreement that there is a likelihood of confusion between “ANASTASIA” and “ANASTASIA BEVERLY HILLS” for skin care products. Further, your client’s alleged marks are also confusingly similar to our client’s long prior used “ANASTASIA” marks in which “ANASTASIA” is used with an “A” design (which, with “ANASTASIA”, was appropriated by your client) and with the term “MARIE”. I am certain that you appreciate that confusion between this mark and “ANASTASIA” or “ANASTASIA BEVERLY HILLS” is as likely as confusion between “ANASTASIA” and “ANASTASIA BEVERLY HILLS”. We will be amending the Answer to the Notice of Opposition and counterclaims.

Since the parties are no longer discussing settlement, we are also writing to demand full responses and further document production in connection with the outstanding discovery requests. We will also be following up shortly with further discovery requests and with scheduling the depositions of Anastasia Soare, Claudia Soare and Darrell Baum.

Robert Berliner  
February 25, 2011  
Page 2

In reviewing the file for this case, I have been astonished by the evasiveness shown in Opposer's responses, document production and in the declarations and briefs filed with the Trademark Trial and Appeal Board.

(1) Interrogatory Responses

With respect to interrogatory nos. 6 and 7, please identify each product and service with which each of the registered marks have been used with at least the specificity with which products and services are identified in the registrations.

With respect to interrogatory nos. 8 and 9, please identify the prices for each and every product and service currently being offered under each of the registered marks – not only for “various, popular” products or “certain” products.

With respect to interrogatory nos. 10 and 11, Opposer has failed to “explain the extent to which there has been any interruption to continuous use” for each of the listed products and services under each mark. We would ask that for each product and service identified, Opposer identify each product and service which has not been provided continuously under the mark since the date of first use, identify when such use ceased and, if applicable, resumed and the reasons for the interruption.

With respect to interrogatory nos. 14 and 15, Opposer has failed to provide the requested information as to advertising of each product and service under each mark, including the dates of such advertising the product or service.

(2) Document Production

The document production has been extremely deficient and does not even remotely represent a good faith effort to comply with the document production requests.

In the first two document request, Applicant requested finished production specimens of a number of products as placed on sale in interstate commerce under the marks as of September 1, 1999. There has been no responsive production. Please confirm that no products were being sold at that time.

In document production request nos. 3 and 4, Applicant requested finished production specimens bearing the registered marks as sold in interstate commerce as of September 1, 2000. There has been no responsive production. Please provide such finished production specimens to the extent that any products existed as of that date and confirm that the documents are responsive to the specific request.

Robert Berliner  
February 25, 2011  
Page 3

Document production request nos. 5 and 6, 23 and 24 request all documents relating to the sales of listed products during the calendar year 2001. There has been no responsive production other than two purchase orders without any indication as to whether the products identified therein or the packaging bore either mark and an invoice relating to fragrance candles. As to each of the listed products, please provide documents sufficient to show the sales of that product during 2001 and advise as to whether these documents are directly responsive as to each document request (i.e. requesting sales documents relating to products bearing the mark) or advise that sales documents do not exist. We are not asking for every invoice (representative invoices are sufficient), but we do request documents such as sales summaries sufficient to show the sales of each product under each mark during that period.

Document production requests 7 and 8, 25 and 26 make the same request as to 2002, and the production is limited to three invoices, again without any indication as to whether these apply to the listed products for each mark. As to each of the listed products, please provide documents sufficient to show the sales of that product during 2002 and advise as requested above.

The document production relating to sales figures for 2003 in response to request nos. 9 and 10, 27 and 28 is limited to a single invoice relating to fragrance candles. For each of the requests, please produce documents and advise as requested above.

There was no production of any sales documents for 2004 through 2008 as requested in document production request nos. 11 – 20, 29-38. For each of the requests, please produce documents and advise as requested above.

Document production request nos. 21 and 22 make the same request as to 2000. You have produced a handful of documents without any indication as to whether these apply to listed products bearing the marks. For each of the requests, please provide documents and advise.

Document production request nos. 40-42 request documents showing shipments in interstate commerce of finished production specimens of listed goods bearing the registered marks from September 1, 1999, to September 1, 2008. Please identify the documents responsive to each of the requests.

With respect to document requests nos. 43-46 request documents relating to the formulation and development of products to be sold under each of the registered marks prior to September 1999 and prior to September 30 2000. You have identified documents which show or describe products sold to your client in 1997 and 1998. Since even the alleged first use of either of the marks was not until 2000, these do not appear to be responsive documents. We will amend the requests to ask for documents dated prior to September, 2000, which specifically

Robert Berliner  
February 25, 2011  
Page 4

relate to the development and formulation of any product sold under either of the registered marks prior to that date.

Please advise by no later than **Friday, March 4.**

Sincerely,

A handwritten signature in dark ink, appearing to read "Brewster Taylor", written in a cursive style.

Brewster Taylor

BT/pak

# EXHIBIT 2



ANASTASIA BEVERLY HILLS, INC.	)	Opposition No. 91,188,736
ANASTASIA SOARE	)	
ANASTASIA SKIN CARE, INC.	)	
	)	
Opposers	)	<b>OPPOSERS'</b>
	)	<b>OBJECTIONS AND</b>
v.	)	<b>RESPONSES TO</b>
	)	<b>APPLICANT'S FIRST SET</b>
ANASTASIA MARIE LABORATORIES, INC.	)	<b>OF INTERROGATORIES</b>
	)	
Applicant	)	

## GENERAL STATEMENT AND OBJECTIONS

1. OPPOSERS' factual investigation, and its efforts to locate and gather documents relevant to this litigation, is ongoing. OPPOSERS anticipate that, in the course of further investigation, additional facts and/or documents will be discovered which might affect its responses to these Interrogatories. OPPOSERS therefore reserve the right to amend and/or supplement its

products are available on the Anastasia Beverly Hills website at the URL <www.anastasia.net>. OPPOSERS further direct AML to production document numbers ABH010135 (a Pro-Forma sales receipt showing current retail pricing for certain ANASTASIA BEVERLY HILLS branded products at the ANASTASIA BEVERLY HILLS salon) ABH010136- & ABH010137- (a menu of services with prices as performed at the ANASTASIA BEVERLY HILLS salon) and ABH030024TS thru ABH030026TS (a wholesale Order Form "rev 11/10/08" showing retail and wholesale pricing for certain ANASTASIA BEVERLY HILLS branded products).

**INTERROGATORY NO. 10**

For each product and service requested to be identified in Interrogatory No. 6, explain the extent to which there has been any interruption to continuous use of the A ANASTASIA BEVERLY HILLS mark to identify the product and services.

**RESPONSE TO INTERROGATORY NO. 10:**

OPPOSERS incorporate each of their General Objections as though fully stated herein. OPPOSERS continue to investigate the subject matter of this Interrogatory and reserve the right to modify, amend or supplement their response as additional information becomes available. Without waiving, and subject to their objections, OPPOSERS respond as follows:

OPPOSERS have discontinued production of A ANASTASIA BEVERLY HILLS-branded foundation, bronzing products and bronzing liquid from in or about October 2009 to the present while the products are being reformulated for reintroduction in 2010.

OPPOSERS discontinued production of A ANASTASIA BEVERLY HILLS-branded lipsticks for approximately one year in or about 2007 while the products were being reformulated.

OPPOSERS discontinued production of A ANASTASIA BEVERLY HILLS-branded facial serum, eye gels and eye-area gels from in or about 2001 to in or about November 2006.

Sales of A ANASTASIA BEVERLY HILLS-branded fragranced creams and lotions, body creams, body lotions, body moisturizers and hand creams were interrupted in 2005.

OPPOSERS have offered manicure services in an A ANASTASIA BEVERLY HILLS-branded salon in the past and are planning to offer such services in an A ANASTASIA BEVERLY HILLS-branded salon in early 2010.

**INTERROGATORY NO. 11**

For each product and service requested to be identified in Interrogatory No. 7, explain the extent to which there has been any interruption to continuous use of the ANASTASIA BEVERLY HILLS mark to identify the product and services.

**RESPONSE TO INTERROGATORY NO. 11:**

OPPOSERS incorporate each of their General Objections as though fully stated herein. OPPOSERS continue to investigate the subject matter of this Interrogatory and reserve the right to modify, amend or supplement their response as additional information becomes available. Without waiving, and subject to their objections, OPPOSERS respond as follows:

OPPOSERS have discontinued production of ANASTASIA BEVERLY HILLS-branded foundation, bronzing products and bronzing liquid from in or about October 2009 to the present while the products are being reformulated for reintroduction in 2010.

OPPOSERS discontinued production of ANASTASIA BEVERLY HILLS-branded lipsticks for approximately one year in or about 2007 while the products were being reformulated.

services, and the expertise of its principal, Anastasia Soare, have been featured in general-interest magazines and newspapers throughout the United States and the world.

Dated: November 13, 2009

/JMM\*20091113/

---

John M May  
Attorney for Opposers  
**ANASTASIA BEVERLY HILLS, INC.**  
**ANASTASIA SOARE**  
**ANASTASIA SKIN CARE, INC.**

John May, Attorney-at-Law  
707 Woodland Drive  
Sierra Madre, CA 91024  
(626) 355 4607  
[john@may.us](mailto:john@may.us)

#### **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the document **Opposers' Objections and Responses to Applicant's First Set of Interrogatories** is being served this date upon Applicant Anastasia Marie Laboratories, Inc. by email, by agreement, upon Opposers' counsel, Daphne Sheridan Bass, at <daphneb@earthlink.net>.

Dated: November 13, 2009

/JMM\*20091113/

---

John M May  
Attorney for Opposers  
**ANASTASIA BEVERLY HILLS, INC.**  
**ANASTASIA SOARE**  
**ANASTASIA SKIN CARE, INC.**

# EXHIBIT 3

# Berliner & Associates

U.S. and International Intellectual Property Matters  
555 West Fifth Street, 31st Floor  
Los Angeles, California 90013  
[www.berliner-ip.com](http://www.berliner-ip.com)

jmay@berliner-ip.com

Telephone: (213) 533-4176

Facsimile: (213) 533-4174

April 5, 2011

VIA E-MAIL AND FIRST CLASS MAIL

Brewster Taylor, Esq.  
Stites & Harbison PLLC  
TransPotomac Plaza  
1199 North Fairfax Street, Ste. 900  
Alexandria, VA 22314-1437  
btaylor@stites.com

Dear Mr. Taylor:

This will serve as a response to your letter of February 25, 2011, to my colleague Robert Berliner. This letter will not address the recent course of settlement negotiations except to note that the details of our prior discussions on this subject were and shall remain privileged and confidential and that our respective clients apparently have not totally foreclosed all possibility of achieving a mutually-agreeable settlement of this matter.

We are surprised by your assertion that your client used "ANASTASIA" alone as a trademark for skin-care products even prior to the 23 May 2000 date claimed in its published application, which appears to be inconsistent with Ms. Chehak's sworn deposition testimony. When do you expect to be in a position to produce credible evidence to substantiate such a claim? In any event, we must protest the obvious prejudicial effects the late disclosure of any such evidence will have on our client, and expect your client will reimburse us for all costs associated with taking a second deposition of Ms Chehak.

We take strong exception to the unsubstantiated allegations in the second paragraph of your letter. Specifically, we dispute: (1) that my client's use of its ANASTASIA BEVERLY HILLS word mark and its A ANASTASIA BEVERLY HILLS & Design mark (collectively, the "ABH mark" or "ABH brand") creates a likelihood of consumer confusion with your client's A ANASTASIA MARIE logo; (2) the implication that your client's use of the A ANASTASIA MARIE logo constitutes "use" of the single word ANASTASIA word mark; and (3) your allegation that my clients appropriated the A ANASTASIA MARIE logo.

We also take this opportunity to note that your client's registered A ANASTASIA MARIE logo places equal emphasis on the words "ANASTASIA" and "MARIE" and includes a distinctive logo consisting of a serif-font "A" and a thistle-like flower bracketed by two inverted

The firm has long established associates in

Australia • Brazil • Canada • China • Finland • France • Germany • Hong Kong • Ireland • Israel • Italy • Japan • Mexico • New Zealand • Philippines  
Singapore • South Africa • South Korea • Spain • Switzerland • Taiwan • The Netherlands • The United Kingdom

Brewster Taylor, Esq.  
April 4, 2011  
Page 2

triangles and surrounded by a square border. In contrast, our client's A ANASTASIA BEVERLY HILLS & Design mark emphasizes the ANASTASIA name; the BEVERLY HILLS component of the mark is disclaimed (also in our Word Only registration). Moreover, the graphic elements of the A ANASTASIA BEVERLY HILLS logo is quite different than your client's logo; all of the text is rendered in a flowing, stylized script, with the "A" element surrounded by a circle, not a square, without the triangles and thistle which appear to be the most prominent design elements of your client's logo.

As to the likelihood of confusion between the ANASTASIA component of your client's A ANASTASIA MARIE registration and the three word phrase ANASTASIA BEVERLY HILLS, we have solid evidence of over 5 years of continuous use of the ABH brand on many of the IC003 goods listed in our registration, and accordingly, likelihood of confusion is not a proper basis for cancellation as to all of class IC003. We will object to any attempt by your client to amend its Answer and Counterclaims to assert this theory, raised for the first time in your February 25 letter.

As to your "astonishment" regarding our discovery responses to date, we take strong exception to your mischaracterization of our discovery responses, document production and "declarations and briefs filed with the Trademark Trial and Appeal Board" as "evasive."

Your intent to depose Anastasia Soare and her daughter Claudia, as well as Mr. Baum, is duly noted. All three currently reside in California, but they all have busy schedules and frequently travel out of state. Assuming you want to take all three depositions in succession please let us have sufficient advance notice of your preferred dates that we can coordinate their respective schedules.

As to your specific comments regarding my client's Interrogatory responses, we respond as follows:

(1) Interrogatory Responses

With respect to Interrogatory Nos. 6, 7, 10 and 11, we direct you to the chart, sent to Daphne Bass in draft form via email dated December 29, 2009 (the "ABH Product Chart"), detailing specific ABH-branded products corresponding to the general product types described in the trademark registrations for the ABH mark and the dates during which the products were sold and shipped in interstate commerce. A copy of that email and the attached ABH Product Chart is enclosed for your convenience. Please note that the chart is classified CONFIDENTIAL pursuant to the protective order in this matter. As detailed below and in our responses to your 3<sup>rd</sup> set of Requests for Production, we are in the process of updating the chart to include details of unit sales for our current IC 003 products for successive 6 month periods commencing January 2005.

You object to our use of the terms "various," "popular" and "certain" in our responses to Interrogatory Nos. 8 and 9, which seek information concerning the retail price of products and services identified in ABH's responses to Interrogatory Nos. 6 and 7. The phrases "various" and "certain" were used not to be evasive, as you seem to imply, but to describe the contents of production documents ABH010135 – ABH010137 and ABH030024TS – ABH030026TS. These documents provide the retail prices for each IC003 product identified in the ABH Product Chart as being sold from some date in the past to the present.

With respect to Interrogatory Nos. 14 and 15, our response directed you to production documents ABH030028TS – ABH030028TS, which set forth specific dates and amounts paid to various print media for advertising ABH branded products in the years 2007- 2009. We plan to supplement our production with documents sufficient to show representative dates on which ABH has advertised or promoted ABH-branded products or services in, on or through specific printed and electronic media publications, outlets or corporations from 2003 through January 2011. Document number ABH010023TS provides yearly promotion, advertising and marketing expenditures in the years 1999 through 2008.

## (2) Document Production

We take issue with your characterization of the document production as "extremely deficient" and "not even remotely represent[ing] a good faith effort to comply" with the requests.

Your letter alleges that "[t]here has been no responsive production" in response to AML's document requests 1 through 4, and demands that ABH either produce finished production specimens of products sold in interstate commerce in 1999 and 2000 or "confirm that no products were being sold at that time." As you should be aware, prior counsel for AML, Daphne Bass, visited ABH's distribution center in Sylmar, California, on or about December 16, 2009. Ms. Bass was given full access to historical documents of ABH concerning the subject matter of the document requests, and allowed to inspect and copy all responsive documents and things, including all historical finished production specimens in ABH's possession. As you should also be aware, if ABH did not keep a finished production specimen of a particular ABH-branded product placed in commerce in 1999 or 2000, that does not constitute proof that no such specimen ever existed or was not ever placed in interstate commerce. Again, we refer you to ABH's document production, and the ABH Product Chart (footnoted to reference supporting evidence produced by ABH) to demonstrate what ABH-branded products were sold and when.

As to your comments regarding our responses to specific requests for documents and things, we respond as follows:

Production documents ABH020110C – ABH020115C and ABH020117C – ABH020124C show shipment in interstate commerce in 2000 of the following ABH-branded products listed in Document Request Nos. 5, 21 and 41: foundation; concealer; pressed powder; loose powder; eye shadow base (*i.e.*, concealer); blush; lip coverings; lipstick; lip gloss; lip liner;



bronzing liquid; eye shadows; mascara; eyeliners; eyebrow color pencils; eyebrow pencils; eyebrow powder; eyebrow pomade; and eyebrow gel.

Production documents ABH020117C – ABH020124C show shipment in interstate commerce in 2000 of the following ABH-branded products listed in Document Request Nos. 5, 21, 23, and 41: foundation; concealer; pressed powder; loose powder; eye shadow base (*i.e.*, concealer); blush, bronzing liquid (*i.e.*, oil-free and moisturizing makeup); eye shadow; mascara; eye liner; lip coverings; lipstick; lip gloss; lip liners; eyebrow color pencils; eyebrow pencils; eyebrow powder; eyebrow pomade; and eyebrow gel.

Similarly, production documents ABH020117C – ABH020124C show shipment in interstate commerce in 2000 of the following ABH-branded products listed in document request nos. 6, 22, 24, 40 and 42: eye creams, eye-area moisturizers, facial moisturizers and eye-area creams (*i.e.*, after-tweeze cream); and eye gels, eye-area gels and facial serums (*i.e.*, pre-tweeze gel).

Production documents ABH020213C – ABH020216C reflect the purchase in 2001 of other IC 003 goods, including room fragrances (*i.e.*, pillar candles) that were sold as ABH-branded products in the ABH salon.

Production documents ABH020140C, ABH020143C and ABH020144C show sales and shipment in interstate commerce in 2002 of the following ABH-branded IC003 products listed in Document Request Nos. 7, 25 and 41: foundation, concealer and eye shadow base (*i.e.*, concealer); pressed powder and blush (*i.e.*, blush); eye shadows; mascaras; eye liners; lip coverings; lipstick; lip gloss; lip liners; eyebrow color pencils; eyebrow pencils; eyebrow powder; eyebrow pomade and eyebrow gel.

We plan to supplement our production with a detailed listing of specific ABH-branded products shipped by the client organized for each semiannual period from 2005 to the present, and a summary thereof keyed to the IC003 goods described in our involved registrations.<sup>1</sup> I believe that our supplemental production should satisfy your concerns as to Document Request Nos. 13 – 20 and 31 – 38.

We have contacted Kolmar Laboratories, Inc. ("Kolmar") regarding any documents (including specifically computer records) which they may have retained reflecting the sale and shipment of ABH-branded products from 1999 through the present. It is our understanding that they should be able to provide detailed invoices for that entire period. Paper copies of some of these invoices have already been produced from our client's files.

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<sup>1</sup> I informed Ms. Bass, in an email dated January 17, 2010, to which I received no response, that my clients would rely on reports generated by my client's electronic business record system for evidence of shipments and sales of ABH-branded products from 2005 to the present. A copy of that email is attached for your convenience.

Brewster Taylor, Esq.  
April 4, 2011  
Page 5

As to Advanced Distribution Systems, Inc. ("ADS") I am informed that ADS has not retained any detailed records reflecting their prior work for ABH. However, we have already provided Ms Bass with copies of relevant documents from ADS, and an opportunity to inspect the ABH document archives in which those ADS documents were located.

As to Document Request Nos. 43 through 46, we do not understand your objections. The Requests seek documents relating to "the formulation and development" of ABH-branded products "dated prior to September 30, 1999," and documents "dated prior to September 30, 2000." Yet your letter complains that documents "describe[ing] products sold to [ABH] in 1997 and 1998" are not responsive because ABH claims a first-use date of its mark in 2000. It only stands to reason that the formulation and development of ABH-branded products and packaging (including price quotations and delivery of product samples, artwork, and packaging) would take place prior to the first use date of the mark. Moreover, our amended dates of first use and first use in commerce were explicitly qualified "at least as early as."

We trust that the foregoing addresses the concerns stated in your February 25 letter. If not, we would be happy to arrange a time to further discuss these issues.

Very truly yours,

/John M May/

---

John May

Encl.

JM/ss

cc: R. Berliner, Esq.

**EXHIBIT 4**

**FILED UNDER SEAL**

# EXHIBIT 5

April 11, 2011

VIA E-MAIL

John May  
Berliner & Associates  
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Los Angeles, CA 90013

TransPotomac Plaza  
1199 North Fairfax Street  
Suite 900  
Alexandria, VA 22314-1437  
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*Brewster Taylor*  
*(703) 837-3906*  
*(703) 518-2935 FAX*  
*btaylor@stites.com*

Re: ABH v. AML – Opposition No. 91188736

Dear Mr. May:

This will acknowledge receipt today of the further document production. Our review today shows that you have not provided even the documents which were promised in the responses to our discovery requests, and we will follow up further with respect to the deficiencies. This letter is to follow up on the clear deficiencies even in what has been promised. That is, it is evident both from your letter of April 5 in response to our letter of February 25 and the discovery responses of April 4 that Opposer does not recognize its discovery obligations and that we will need additional time. Since our client does not yet have basic discovery, including but by no means limited to having no information or documents which could show total sales or annual sales of products under your client's mark or, indeed, of annual sales or total sales or any product under your client's mark, and since discovery is scheduled to close in this proceeding on April 26, and since we do not want to schedule depositions until we have the information and documents requested in the discovery requests of our predecessor counsel and our own discovery requests, we ask your agreement to a thirty day extension of times in the discovery and trial schedule. Please advise on this point by return.

First, with respect to your comments concerning AML's use of "ANASTASIA" with an "A" design prior to your client's questionable alleged first use of "ANASTASIA" with an "A" design and the words "BEVERLY HILLS", this will confirm that our client has obtained affidavits and is still obtaining additional affidavits to prove such use. Our client's affidavit will explain how this new information very recently came to light. We expect to have this material to you shortly. Apart from this earlier use of "ANASTASIA" with an "A" design, it, of course, remains the case that your client appropriated the "A" design and "ANASTASIA" from our client's long registered and used "A ANASTASIA MARIE" mark and simply replaced the third and least significant element of the composite mark, "MARIE", with the descriptive words "BEVERLY HILLS". As you are aware, our client's rights in the "A" design and in "ANASTASIA" are more than a decade prior to any use by your client of the "A" design and of "ANASTASIA".

Mr. John May

April 11, 2011

Page 2

Further, we can only conclude from the responses to our letter of February 25 and to both our discovery requests and those of our predecessors that it is simply not possible for your client to substantiate its claims of use of its mark for products or even for its services since March of 2000. It is even evident from the chart which you have created for litigation purposes that a number of products for which you still claimed use of the registered marks in the declaration of use filed during litigation were in fact not in use (following the false declarations of use filed by prior counsel in the applications). The chart is also inconsistent with the claims of excusable non-use in your declarations and with declarations by Anastasia Soare and Darrell Baum. Finally, however, as you appreciate, the claims of use in the chart are all but meaningless without annual sales figures of products under the marks which could provide at least some idea of actual use. The invoices, purchase orders and packing slips referenced in the footnotes to the chart do not remotely begin to substantiate the claims made in the chart.

With respect to your response to our letter concerning deficiencies in the responses to our predecessor's interrogatories, you have directed us to your chart discussed above, but in terms of substantiating the claims of use which are made in the chart, you offer only to provide details of "unit sales for our current IC 003 products for successive 6 month periods commencing January 2005" (which have not been provided in your current production) with no explanation as to why you will not provide information as to the years prior (despite repeatedly claiming that your client has documents sufficient to show sales during the period from 2000 to the present). Since you have claimed use of the mark for products in the chart prior to 2005 why can't you provide the documents which you relied upon to make such claims?

In your e-mail to our predecessor on January 17, 2010, you stated that "our client will commence searching its pre-2005 business records for documentary evidence of early sales and/or shipments of each ABH-branded product". However, there has been virtually no production of documents showing sales prior to 2005, and those documents which have been produced do not show sales of products under the mark. As stated above, our client still lacks even the most basic information as to sales of products under the mark. Nor have you, as requested in Interrogatory Nos. 10-11, either identified or explained "any interruption in continuous use". You have stated that you will supplement the response to Interrogatory Nos. 14 and 15, and we look forward to receipt of the amended response.

With respect to your responses to our letter concerning deficiencies in production in response to document production requests from our predecessor, your summary of the documents which you have produced to date itself shows the glaring insufficiency of the production, and, as you no doubt appreciate, documents showing sales by manufacturers of products to your client for use in her hair salon are not evidence of sales by your client of products under the mark. Finally, please advise whether you are representing that the documents which you produced show the development and formulation of all products sold before September 2000.



The responses to our document requests served on February 28 of this year show a continuing lack of good faith in responding to discovery requests. We will review further the documents you have now produced in connection with the promises to produce made in your responses, but, as stated, it is already apparent that they do not show what you have stated they would show. Further, as also stated, the responses themselves show that you do not intend to provide meaningful discovery. Again, in response to our document production request no. 9, which requests documents sufficient to show the dollar value of actual sales of products under your client's marks for each year beginning with the first year of use, you state that "Opposers will produce representative Salon Retail Commission Reports reflecting income from retail sales in the Anastasia Beverly Hills Salon in 2000, 2001 and 2002. Opposers will also produce documents summarizing units sold of ABH-branded goods in class 3 listed in ABH's Registration Nos. 2821892 and 2798069 on a semi-annual basis from 2005 to the present".

The current document production does not show "income from retail sales" in 2000, 2001, and 2002, but even then, as you are well aware, documents simply reflecting sales in the salon do not provide any information as to sales of "ABH-branded goods", and you have provided no explanation as to why 2003 and 2004 are omitted entirely. Likewise, in response to the same request as to the services rendered in the salon, without explanation, you offer to provide only reports reflecting income from services from 2000, 2001 and 2002. Nor have you provided documents which summarize units of "ABH-branded goods" from 2005 to the present. How can we know the sales of "ABH-branded goods" from the documents which you have produced?

With respect to requests for documents (3 and 23) which would support the claims of first use and the claims of priority, you refer to a set of documents which simply show sales to your client of products for use in her salon and another set of documents (which could not in any event support either the claims of first use or the claims of priority) which show sales to Nordstrom of products for use in the hair salon which your client will establish there. Finally, with respect to document request no. 32 which requests documents sufficient to support the denials made to our requests for admission, as you are certainly aware, the documents which you state will be provided do not even remotely begin to support the denials of requests for admission that you do not have documents sufficient to show the use claimed, and indeed the summaries of documents produced show that the denials are false.

In reviewing the responses to requests for admission, it becomes apparent that there is a pattern of making denials and then qualifying the denials with irrelevant wording in an effort to avoid providing admissions to the actual requests. For example, in denying a request (5) concerning use of the mark in advertising and rendering the services under the mark in September, 1999, you begin with irrelevant and vague discussion about the history of the salon, state that the mark was "adopted" "on or about September 1999" and then discuss use as a mark "commencing in or about the year 2000". More egregiously, you provide this same response in response to a request (8) for an admission that you do not documents sufficient to show

Mr. John May NEW YORK

April 11, 2011

Page 4

continuing use of the mark for services since September 1999, without even mentioning documents and a request for admission (10) that Opposer does not have documents sufficient to show that there has not been a period of at least three years since September 1999 in which the mark has not been used in connection with advertising the services, a request (11) for admission that you do not have documents sufficient to show use as of the alleged first use date, and request (12) for admission that you do not have documents sufficient to show continuous use of the mark for the services since that alleged first use date.

More significantly, this same type of evasion is used with respect to the numerous requests relating to whether Opposer has documents sufficient to show continuing use of the mark for different products. Instead of admitting or denying requests for admission that Opposer does not have documents sufficient to show use or that there has not been three years of non-use, you deny the requests and then qualify the denials with the statements that the mark has in fact been in use, leaving ambiguity as to whether you are denying the request based on the existence of documents or on some unknown criterion of what constitutes use.

You also employ other evasions in the responses to the requests for admission. For example, rather than admit that there has been a period of at least three years when eye shadow was not used, you base your denial of request for admission no. 29 on equating eye shadow with other products in connection with which there has not been a three year period of non-use: "eye shadow (i.e. blush, eye shadows, brow powder)". Also, multiple other separately identified products in the registration are reduced to a single category for the purpose of responding to requests for admission (e.g. "concealer and/or foundation"; "facial moisturizers" and "eye creams" and "eye-area creams"; "eye gels" with "eye-area gels"; "facial serums" with "eye-area gels" and "eyebrow gel"; "eye shadow base" with "concealer"; and "lip coverings" with "lipstick", "lip gloss" and "lip liners").

The Federal rules require that "[i]f a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter; and when good faith requires that a party qualify an answer of deny only a part of a matter, the answer must specify the part admitted and qualify or deny the rest". F.R.C.P. 36(a)(4). Please amend the responses to the requests for admission to conform to the rules.

The responses which have been provided show a continuing effort to conceal facts and create confusion as to your client's actual use of the claimed marks. If Opposer does not have certain categories of responsive documents, we would ask that Opposer state that it does not have



Mr. John May EYS

April 11, 2011

Page 5

responsive documents and state why it does not have the documents rather than providing isolated documents which may or may not support its claims.

Sincerely,

**STITES & HARBISON PLLC**



Brewster Taylor

BT:pak

# EXHIBIT 6

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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ANASTASIA BEVERLY HILLS, INC.  
ANASTASIA SOARE  
ANASTASIA SKIN CARE, INC.

Opposers

v.

ANASTASIA MARIE LABORATORIES, INC.

---

Applicant

) Opposition No. 91188736  
)  
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)  
)

) **Opposers' OBJECTIONS**  
) **AND RESPONSES TO**  
) **APPLICANT'S THIRD SET**  
) **OF REQUESTS FOR**  
) **PRODUCTION OF**  
) **DOCUMENTS AND**  
) **THINGS**  
)

Pursuant to Trademark Rule of Practice 2.120 (37 CFR § 2.120), Trademark Trial and Appeal Board Manual of Procedure § 406 and Federal Rule of Civil Procedure 34, Opposers Anastasia Beverly Hills, Inc. ("ABH"), Anastasia Soare ("AS") and Anastasia Skin Care, Inc. ("ASC") (collectively, "Opposers"), hereby present their objections and responses to Applicant Anastasia Marie Laboratories, Inc.'s ("AML") Third Set of Requests for Production of Documents and Things ("Requests").

**GENERAL STATEMENT AND OBJECTIONS**

The following general objections apply to most, if not all, requests for production, and are in addition to any other specific objections that are stated with regard to each such discovery request:

1. Opposers' factual investigation, and its efforts to locate and gather documents relevant to this litigation, is ongoing. Opposers anticipate that, in the course of further investigation, additional documents will be discovered which might affect its responses to these Requests. Opposers therefore reserve the

**REQUEST NO. 2 (60):**

Produce those documents regarding any investigation such as a service mark, trademark, trade name, Internet name, or corporate name search concerning the selection or first use by any of the Opposers of any of Opposers' Marks or concerning the decision by any of the Opposers to apply for Federal registration of any of Opposers' Marks.

**RESPONSE TO REQUEST NO. 2 (60):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further object and will refuse to produce documents responsive to this Request to the extent that it seeks documents subject to the attorney work product doctrine and the attorney client privilege. Opposers further object and will refuse to produce documents responsive to this request on the ground that, because it seeks information that is neither relevant to the claims or defenses of the parties nor likely to lead to the discovery of admissible evidence, it is overly broad, unduly burdensome and oppressive.

Subject to and without waiving the foregoing objections, Opposers state that they have located no non-privileged documents in their possession, custody or control that are responsive to this request.

**REQUEST NO. 3 (61):**

For each of Opposers' Products, produce those documents sufficient to show the earliest sale of the product under any of the Opposers' Marks anywhere, and the sale of the product under any of Opposers' Marks in commerce.

**RESPONSE TO REQUEST NO. 3 (61):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further

object that the Request is overly broad, unduly burdensome and oppressive to the extent that any responsive documents in Opposers' possession or control have already been produced or made available for inspection and copying by Opposers. Specifically, Opposers' archived business records for the calendar years 2000 through 2008 were made available to counsel for AML in Opposers' warehouse in Sylmar, California, on or about January 16, 2010.

Subject to, and without waiving the foregoing objections, Opposers state that they will produce non-privileged, responsive documents to supplement Opposers' previous document production. Specifically, Opposers will produce documents summarizing units sold of ABH-branded goods in Class 3 listed in ABH's Registration Nos. 2821892 and 2798069 on a semi-annual basis from 2005 to the present. Opposers further respond by directing AML to documents already produced by Opposers, bates-numbers ABH020101C – ABH020105C and ABH020110C – ABH020115C and the chart, sent to Daphne Bass via email dated December 29, 2009 (the "ABH Product Chart"), detailing specific ABH-branded products corresponding to the general product types described in the trademark registrations for the ABH mark and the dates during which the products were sold and shipped in interstate commerce.

**REQUEST NO. 4 (62):**

For each of Opposers' Services, produce those documents sufficient to show the earliest date of rendering the service under any of Opposers' Marks anywhere and the rendering of the services under any of Opposers' Marks in Commerce.

**RESPONSE TO REQUEST NO. 4 (62):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further object that the Request is overly broad, unduly burdensome and oppressive to

available for inspection and copying by Opposers. Specifically, Opposers' archived business records for the calendar years 2000 through 2008 were made available to counsel for AML in Opposers' warehouse in Sylmar, California, on or about January 16, 2010.

Subject to, and without waiving the foregoing objections, Opposers state that they will produce non-privileged, responsive documents to supplement Opposers' previous document production. Specifically, Opposers will produce documents sufficient to show the dates on which ABH has advertised or promoted ABH-branded products or services in, on or through specific printed and electronic media publications, outlets or corporations. Opposers will also produce documents reflecting public relations efforts related to the promotion of ABH-branded products in print and/or electronic media in 2000, 2004, 2005 and 2006. Opposers further respond by directing AML to documents already produced by Opposers, bates-numbers ABH010002 – ABH010061; ABH010079 – ABH010081; ABH010086 – ABH010088; ABH010095 – ABH010097; ABH010105 – ABH010106; ABH010023TS; and ABH030027TS.

**REQUEST NO. 9 (67):**

Produce those documents sufficient to show the dollar value of actual sales of each of Opposers' Products for each year beginning with the date of first use of any of Opposers' Marks in connection with the sale of the product.

**RESPONSE TO REQUEST NO. 9 (67):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further object that the phrase "dollar value of actual sales" is vague and ambiguous. Opposers further object that, because certain ABH-branded products are or have been sold bundled with other ABH-branded products it would be burdensome and speculative to attempt to isolate revenues from sales of such products

individually. Opposers further object and will refuse to produce documents responsive to this request on the ground that, because it seeks information that is neither relevant to the claims or defenses of the parties nor likely to lead to the discovery of admissible evidence, it is overly broad, unduly burdensome and oppressive. Opposers further object that the Request is overly broad, unduly burdensome and oppressive to the extent that responsive documents have already been produced by Opposers. Specifically, Opposers' archived business records for the calendar years 2000 through 2008 were made available to counsel for AML in Opposers' warehouse in Sylmar, California, on or about January 16, 2010.

Subject to, and without waiving the foregoing objections, Opposers state that they will produce non-privileged, responsive documents to supplement Opposers' previous document production. Specifically, Opposers will produce representative Salon Retail Commission Reports reflecting income from retail sales in the Anastasia Beverly Hills Salon in 2000, 2001 and 2002. Opposers will also produce documents summarizing units sold of ABH-branded goods in Class 3 listed in ABH's Registration Nos. 2821892 and 2798069 on a semi-annual basis from 2005 to the present.

**REQUEST NO. 10 (68):**

Produce those documents sufficient to show the dollar value of income received from rendering each of Opposers' Services for each year beginning with the first use of any of Opposers' Marks in connection with the rendering of the service.

**RESPONSE TO REQUEST NO. 10 (68):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further object and will refuse to produce documents responsive to this request on the

ground that, because it seeks information that is neither relevant to the claims or defenses of the parties nor likely to lead to the discovery of admissible evidence, it is overly broad, unduly burdensome and oppressive. Opposers further object that the Request is overly broad, unduly burdensome and oppressive to the extent that responsive documents have already been produced by Opposers. Specifically, Opposers' archived business records for the calendar years 2000 through 2008 were made available to counsel for AML in Opposers' warehouse in Sylmar, California, on or about January 16, 2010.

Subject to, and without waiving the foregoing objections, Opposers state that they will produce non-privileged, responsive documents to supplement Opposers' previous document production. Specifically, Opposers will produce representative Salon Service Commission Reports reflecting income from services rendered in the Anastasia Beverly Hills Salon in 2000, 2001 and 2002.

**REQUEST NO. 11 (69):**

Produce those documents sufficient to show the amount of money expended to promote Opposer's Products and Opposer's Services under any of the Opposers' Marks for each year beginning with the date of first use of the mark.

**RESPONSE TO REQUEST NO. 11 (69):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further object that the Request is overly broad, unduly burdensome and oppressive to the extent that the request is duplicative of AML's Request Nos. 47 and 48 and that any responsive documents have already been produced or made available for inspection and copying by Opposers. Specifically, Opposers' archived business records for the calendar years 2000 through 2008 were made available



**REQUEST NO. 23 (81):**

Produce any and all documents that support Opposers' position of having prior rights with respect to the use of "ANASTASIA" as or in a mark for skin care products.

**RESPONSE TO REQUEST NO. 23 (81):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Opposers further object that the Request is overly broad, unduly burdensome and oppressive to the extent that any responsive documents in Opposers' possession or control have already been produced or made available for inspection and copying by Opposers. Specifically, Opposers' archived business records for the calendar years 2000 through 2008 were made available to counsel for AML in Opposers' warehouse in Sylmar, California, on or about January 16, 2010.

Subject to, and without waiving the foregoing objections, Opposers state that they will produce non-privileged, responsive documents to supplement its previous production of documents responsive to this request. Opposers further respond by directing AML to documents already produced by Opposers, bates-numbers ABH020091C – ABH020105C and ABH020110C – ABH020115C.

**REQUEST NO. 24 (82):**

Produce any and all documents that support Opposers' position that there is a likelihood of confusion between any of Opposers' Marks and the mark in Application Serial No. 77150306.

**RESPONSE TO REQUEST NO. 24 (82):**

Opposers incorporate by reference each of their General Statements and Objections set forth above as though fully set forth herein. Subject to, and without waiving the foregoing objections, Opposers state that they will produce

# EXHIBIT 7

# Berliner & Associates

U.S. and International Intellectual Property Matters  
555 West Fifth Street, 31st Floor  
Los Angeles, California 90013  
[www.berliner-ip.com](http://www.berliner-ip.com)

jmay@berliner-ip.com

Telephone: (213) 533-4176  
Facsimile: (213) 533-4174

April 13, 2011

VIA E-MAIL ONLY

Brewster Taylor, Esq.  
Stites & Harbison PLLC  
TransPotomac Plaza  
1199 North Fairfax Street, Ste. 900  
Alexandria, VA 22314-1437  
btaylor@stites.com

Dear Mr. Taylor:

I acknowledge receipt of your letter of April 11, 2011.

What you characterize as "evasive" is in fact a good faith attempt to comply with our discovery obligations under the federal rules, despite the fact that both your firm and your client's prior counsel have served us with unnecessarily burdensome, duplicative, and irrelevant requests and interrogatories.

In our early disclosures to your predecessor counsel, we provided considerable relevant dated documentation from the 1999-2003 time period showing both early internal use (packaging, artwork, price quotations, etc) of the marks in question prior to the filing of the relevant applications and subsequent shipments in interstate commerce of representative goods in all four classes; that same counsel had ample opportunity to inspect additional potentially relevant documents from the formation of the company to the present as maintained by ABH in the ordinary course of business, including the possibility of requesting customized reports from the company's computerized records and/or taking oral discovery of our corporate clients under rule 30b6. Moreover, we were receptive to continuing "informal discovery" even while the MSJ was pending.

In support of our motions to amend and for summary judgment, we made of record a detailed sworn declaration from Ms. Soare that clearly admitted that certain goods had not been shipped in interstate commerce bearing the marks in question prior to registration, and that there was no specific plans to so ship certain other branded goods in the foreseeable future. If you believe it useful to recast that declaration as a series of requests to admit certain facts set forth in particular paragraphs, we will promptly respond without objection.

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April 13, 2011  
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As to our discovery responses regarding the production of reports reflecting unit shipments or sales of ABH-branded products from 2005 to 2010, I was told in the presence of your predecessor, Ms. Bass (who was given the opportunity to informally interview our clients' warehouse manager, Mr. Stan, and their accountant, Ms. Carp) that ABH's inventory control software was not operational until January 2005. As to the format of such reports, not hearing back from Ms. Bass, I decided on a format which is intended to balance detail with lucidity.

Subject to your acknowledgment that it should suffice for the 2005-2010 time period, I plan to send you separately on CD-ROM a rather detailed spreadsheet in Excel format summarizing shipments of specific Class 3 goods identified in our amended registrations for each of 12 successive 6-month periods from January 2005 to December 2010, to be designated Trade Secret and Commercially Sensitive under the Protective Order, as well as similarly designated raw output from the client's "Fishbowl" inventory control system (in csv format) for individual SKU's which were combined to provide the numerical data included in the Excel spreadsheet. I believe that this will be sufficient to establish 5 years substantially continuous use of the registered marks on the goods listed in the involved amended registrations from the first half of 2005 to the last half of 2010. My client is extremely concerned about its most sensitive sales data falling into the hand of its competitors, and has instructed me to make it available only for your use (and that of your trusted associates and paralegals and experts) under the strictest provisions of the Protective Order.

I attach a printout of a much a less detailed summary from the same spreadsheet which is based on the same input data and the same internal logic, but producing a visible output with the unit quantities replaced by zero, one or two hash marks indicating respectively no, some, or many units shipped. We expect to use this chart (or a modified version thereof) as a trial exhibit demonstrating use in commerce of the registered ABH and AABH marks on the various listed Class 3 goods over the last 6 years sufficient to establish the incontestability of those registrations for at least some of those listed goods. Please treat it as CONFIDENTIAL under the Protective Order.

Our clients are unable to provide computer generated reports of shipments or sales of individual products during designated time periods prior to 2005, but rather such information must be manually extracted from paper documents that were retained in the normal course of business, relating to shipments from vendors and former vendors such as Kolmar Laboratories, Inc. ("Kolmar") and Automated Delivery Systems, Inc. ("ADS"), or to customers and former customers such as Fred Segal, Nordstrom, and Sephora. We already have produced a number of such documents which we believe sufficient to show "use in commerce" of the registered AABH and ABH trademarks at all relevant times on those goods not already deleted from the registrations. As to any sales or shipments of the deleted goods (which would be relevant only to the "fraud" counterclaim), I refer you to Ms. Soare's declaration and to the previously produced documents, including invoices from Kolmar and Baden Aromatherapy.

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I would note that to the extent we have produced documents establishing at least some use in 2003 and in 2005 for certain goods, there is no logical possibility of a 3 year period of non-use subsequent to 2001 or prior to 2007 that would lead to a presumption of abandonment as to those goods. In any event should you have demonstrable need for additional representative documents involving a limited number of specific products, vendors, customers and dates for the years prior to 2005, (i.e., prior to the availability of detailed computerized inventory records), we will attempt to locate additional such documents for you. Alternatively, you are welcome to inspect the relevant business records (document depositories) in which we would expect that such documents would be located.

I confirm that we expect to be producing additional documentation regarding shipments of specific products from Kolmar during the period 1999-2004. Your predecessor already had an opportunity to review our clients' hard copies of Kolmar invoices from each of those years, but apparently was not interested in hiring a copy service to make copies of same. In any event, I have requested Kolmar to provide us with electronic copies of all their invoices to ABH from that time period, and will make a copy of same for your inspection. I hope to have this by the end of the week. Note that as clearly documented in our early disclosures, some of the products were delivered by Kolmar in finished goods form, some were intended to be subsequently packed into boxes or assembled into kits, some were to be used only as testers. At this time, we are not representing that all the products shipped by Kolmar were already branded with the AABH and ABH marks prior to shipment by Kolmar; however, the already produced documents clearly show that at least the 0.7 oz tube version of pre tweeze gel and after tweeze cream was packed by Kolmar into tubes preprinted by Tube Products, Inc. with the relevant marks prior to shipment by Kolmar to ADS.

We also have located and have offered to make available for your inspection a large number of paper documents reflecting finished goods sold and shipped to Nordstrom prior to 2005.

As to your request for a 30 day extension for discovery and trial, our clients have instructed us to obtain a final resolution of this matter as expeditiously as possible. I certainly understand your desire to have an opportunity to review all relevant documents prior to taking any deposition of my client, but your latest set of discovery requests overlapped (both in subject matter and numbering) that of your predecessor and I do not wish to open up my clients to even more burdensome and duplicative discovery than that to which they have already been subjected.

Accordingly, I propose that we attempt to work out a detailed discovery plan (covering not only requests to admit, but also document production and depositions) that can be completed in the next 45 days or so, with minimal burden on any party. Regardless of whether or not that objective can be achieved (and I sincerely believe it is realistic), you may be assured that we will not oppose any deposition notices of our clients and identified potential witnesses or any motions to compel as untimely if made within 30 days of our production of additional relevant documents (if we are able to agree on appropriate ground rules for any pending or timely made future

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requests) or within 30 days following a conference with the Interlocutory Attorney (if we are not able to so agree), with a corresponding adjustment by mutual consent of all subsequent trial dates. I assume you are willing to make a similar commitment as to any deposition of your client (or other potential witnesses) regarding your not yet produced "new evidence."

I will now address certain other specific issues raised in your letter that I find particularly troubling:

Your RFA 10 calls for a **triple negative** admission: Opposer does **not** have documents sufficient to show that there has **not** been a period of at least three years since September 1999 in which the mark has **not** been used in connection with advertising the services. We understand "documents" to embrace more than just paper files maintained in the ordinary course of business and stored in a manner that facilitates retrieval by date and subject. "Sufficient to show" and "in connection with" require legal conclusions, not just facts. Moreover, this and other similar requests appear to be merely a fishing expedition for evidence to support an unasserted counterclaim for cancellation of our pleaded service marks in class IC044, and it would be extremely prejudicial to add any such counterclaim at this late stage of the proceeding.

ABH's early business records for the relevant time periods remain available for your inspection in accordance with the applicable provisions of the Federal Rules and the Protective Order. Indeed, many of the relevant facts are already of public record in this proceeding either in the TDR prosecution records of the involved registrations or in the pleadings, motions, exhibits and orders that are accessible through TTABVUE. Your allegations of an intent to conceal and confuse is baseless and unwarranted.

I look forward to working with you on a mutually acceptable plan to conclude discovery promptly without undue burden on either party. If we can not agree on such a plan, I think the next step is to schedule a discovery conference with the Interlocutory Attorney.

Very truly yours,  
/John M May/  
John May

cc: Robert Berliner, Esq.

# EXHIBIT 8

April 14, 2011

**VIA EMAIL ONLY**

John May, Esq.  
Berlinger & Associates  
555 West Fifth Street, 31st Floor  
Los Angeles, California 90013

Brewster Taylor  
(703) 837-3906  
(703) 518-2936 FAX  
btaylor@stites.com

RE: ABH v. AML – Opposition No. 91188736

Dear Mr. May:

This will acknowledge receipt of your letter of April 13. Although you have suggested that our discovery requests have been excessive and have described your efforts to provide discovery, the fact remains that, despite its best efforts, our client has been unable to obtain basic discovery as to the products and services allegedly provided under the mark. Both we and our predecessor counsel have been unable to find out the basis, if any, for Opposer's claims of first use and continuing use of its marks.

Apart from the fact that the "confidential chart" which you have provided as to the marks and use for individual products is demonstrably and dramatically inconsistent with the documents which have been produced and the declarations which have been made, you have either refused or, as is more likely the case, been unable to produce documents on which you could have reasonably relied to prepare the chart. If the document production which has been made to date is what was relied upon in creating the chart, it is very clear that the claims made in the chart are largely fictional. Where did the claims made in the chart or in the various declarations which have been filed come from if they were not based on documents?

Beginning with the false declarations of use made in the applications and continuing with the false declarations under Section 8, there is a continuing pattern of deception and fraud, and I am convinced that the reason that we have not yet received any indication of the amount of sales for any product under the alleged marks for any year, much less any sales totals, is that if you were forthcoming as to actual sales of individual products under the marks, we would see abandonment as well as further evidence of fraud.

While I do not understand why such information was not provided earlier, we look forward to receipt of the spreadsheet for shipments of product for the 2005-2010 time period and the SKUs which were combined to provide the numerical data included in the spreadsheet. However, it is not clear whether the spreadsheet will be limited to products which have been sold

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under the marks at issue and whether it will show sales of the products under these marks to others. Please advise on these points.

With respect to the important years between the claims of first use in 2000 and 2005, in the "confidential chart" and in the various declarations, there have been very specific claims as to which of the products were being sold under the mark at different times and which of the products were not being sold. You have stated that you are unable to provide computer generated reports of shipments or sales for this period but not that you are unable to provide annual sales figures for each of the products sold under the claimed marks and the documents from which the sales figures were derived. It is very evident from the materials we have seen that your client would keep track of the sales of products under the marks at issue, and I believe that you are perfectly capable of producing these figures but do not do so because of what they would show.

You have offered to provide additional documentation concerning shipments of products from Kolmar, but, as we have stated previously, we can have no idea from these documents whether these shipments included products bearing the marks at issue. Similarly, we can have no idea of how many products were sold under the marks from reports showing income from all retail sales in the Salon or the "large number of paper documents reflecting finished goods sold and shipped to Nordstrom prior to 2005". Again, we believe that your client has records which show the actual sales of products under the marks just as it would have records of sales of products sold under another company's marks and that you are simply attempting by all means possible to avoid producing these records.

You have likewise not responded to my request for an explanation of why you have offered to provide only reports reflecting income from services rendered in the ABH salon from 2000, 2001 and 2002. Instead, you simply claim that an attempt to add counterclaims for cancellation of your service marks would be "extremely prejudicial". If discovery indicates that claims made with respect to the service marks or the product marks are fraudulent and/or that the marks were abandoned, we can certainly amend to include counterclaims for cancellation.

Just as you have sought to avoid providing meaningful discovery, you have likewise avoided responding meaningfully to my letter of April 11. For example, you ignored my requests to confirm that you have produced all documents relating to development and formulation of all products sold before September 2000, and you did not respond to the statement of clear deficiencies in the documents which would allegedly support first use. Further, you have simply ignored the substance of my statements concerning the obvious deficiencies in the responses to the requests for admission and the obvious inconsistency of the responses with the document production and focused on a single request for admission. However, your claims as to

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that request are themselves disingenuous. Regardless of how you may describe the request, it is perfectly understandable. If Opposer has documents showing that use of the mark in connection with advertising and providing services has been continuous at least to the extent that there has been no three year period of interruption of providing the services under the marks, the request would easily be denied. Your response is one example among many of a refusal to be straightforward.

With respect to your recent document production, while, again, we are surprised that you did not produce the documents earlier, as I am sure you appreciate, you have simply tried to substitute quantity for meaningful discovery. In the nearly 4000 documents that you produced, you produced very few of the documents that you promised to produce in your responses to our document requests. For instance, your responses to our discovery requests indicated that you would produce non-privileged documents responsive to our client's request for documents evidencing the earliest sale of the product. From our thorough review of the documents provided, specifically, the summary of "Sales by Customer Detail", arguably, the earliest sale was in September 2000. However, as stated above, we can have no idea from these documents whether these were products sold under the marks or whether they were simply beauty and skin care products sold to various customers. The documents titled "Sales by Customer Detail" were only provided for the years 2000 and 2001. What about the years 2002 through the present?

Likewise, many of the documents titled "Sales by Vendor" and "Sales by Item Detail" show sales figures under AAS Cosmetics Company, Inc. rather than Anastasia Beverly Hills. These documents do not show actual sales of products under the marks at issue; again, we can have no idea from these documents whether these were products sold under the marks or whether they were simply beauty and skin care products sold to various customers.

In your responses to our document requests, you promised to produce non-privileged documents responsive to our request for documents evidencing the first use of any trade names containing Anastasia. No such documents have been produced. We can see from the documents produced that you have been using "Anastasia" on letterhead as far back as 1999, but the documents produced do not show when the use of "Anastasia" officially began, when the use of "Anastasia Beverly Hills, Inc." began, and when the use of "Anastasia Skin Care, Inc." began.

Your document production also fails to respond adequately to our request for representative specimens of each different type of packaging and labeling materials for each of Opposer's products, including the prototypes, drafts and sketches for said packaging and labeling and those documents regarding the design and/or creation of said packaging and labeling. While Opposer did produce some sketches of packaging and products, such as a sketch of a makeup box and a sketch of a wand, representative specimens of packaging and labeling were not produced for each and every product sold under Opposer's Mark. Further, your suggestion that

John May, Esq.  
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Page 4

we see ABH's website, anastasia.net, for current packaging for ABH-branded products is unacceptable and an insufficient response to our request. Please supplement this response and provide representative specimens of packaging and labeling for each and every product sold under Opposer's Mark.

In your response to our request for documents showing by date each printed and electronic publication in which Opposer has advertised or promoted products or services under the mark, you agreed to produce documents reflecting public relations efforts related to the promotion of ABH-branded products in print and/or electronic media in 2000, 2004, 2005 and 2006. What about the years 2001, 2002, 2003, 2007, 2008 and 2009? We see that you produced documents related to your promotional efforts in 2010 and 2011, but have no way of knowing whether the listing of "confirmed placements for 2010" provided by Opposer represents the promotion of Anastasia Soare or the promotion of products and services under the mark.

Your response to our request for documents showing the dollar value of income received from rendering each of Opposer's services for each year since the date of first use under the mark is insufficient. Opposer has agreed to produce non-privileged responsive documents, specifically Salon Service Commission Reports reflecting income from services rendered in the ABH salon in 2000, 2001 and 2002. What about the years 2003 through the present? If Opposer has documents showing that use of the marks in connection with providing the services listed in Opposer's Registrations has been continuous, these documents should be produced.

In your response to our request for documents that support Opposer's position of having prior rights in the mark "ANASTASIA" for skin care products, you state that Opposer will provide non-privileged responsive documents. However, we have as yet seen no such documents. Please advise as to whether all documents which would allegedly support the position have been produced.

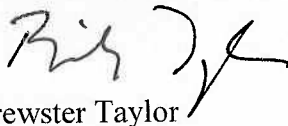
We also asked for documents identifying the legal relationship between each of the Opposers and none have been produced.

We believe that in the absence of an immediate and genuine effort to respond in good faith, the next step will have to be a motion to compel discovery.

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Sincerely,

STITES & HARBISON, PLLC

  
Brewster Taylor

BT:MEG

EXHIBIT 9

FILED UNDER SEAL

## EXHIBIT 10

# EXHIBIT 10

# EXHIBIT 11

## Taylor, Brewster

---

**From:** John May [John@May.us]  
**Sent:** Monday, April 25, 2011 8:08 PM  
**To:** Taylor, Brewster  
**Cc:** Robert Berliner; Sarah Anne Silbert  
**Subject:** Re: Computer reports from ADS / PROTECTIVE ORDER CONFIDENTIAL / ABH V AML

**Attachments:** C- ADS sample pages 10-2002 -C.pdf



C- ADS sample  
pages 10-2002 -C.

Dear Mr Taylor

Attached are photocopies of 3 representative pages from the September 2002 report. PLEASE TREAT THIS INFORMATION AS CONFIDENTIAL UNDER THE PROTECTIVE ORDER.

We are still looking for similar printed computer reports for other time periods prior to 2005, and if we find any, I will promptly advise you. In any event, we have copies of the invoices prepared by ADS (or its successors) and submitted to Nordstrom (which were already produced for inspection by Ms Bass more than a year ago), as well as reprinted invoices from Kolmar reflecting all shipments from Kolmar to ADS or its successors (which you already have). In my opinion, when taken in conjunction with the Fishbowl data already sent you, these documents are more than sufficient to establish whether or not there was a three year period of non use as to any particular goods.

As to dollar volume for particular types of goods, to the extent this information is not evident from what has already been produced (or remains available for your inspection and/or copying), we repeat our earlier objections as to your requests as being burdensome, irrelevant, and untimely.

I await your instructions as to whether you wish to inspect or copy the entire 17" stack. Alternatively, I am willing to ship you the existing copy of the entire September 2002 report, with the understanding that you will keep in a safe and secure place in your offices, and will return it in the same condition at the conclusion of the current litigation.

John M May

Please email any responses or comments to jmay@berliner-ip.com with copy to John@May.us

[see attached file: C- ADS sample pages 10-2002 -C.pdf]